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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/821,027 03/19/97 VOIT

E 680-189

EXAMINER

020277
MCDERMOTT WILL & EMERY
600 13TH STREET NW
WASHINGTON DC 20005-3096

LM02/1126

ART UNIT

PAPER NUMBER

2733

DATE MAILED:

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11/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/821,027

Applicant(s)

VOIT et al.

Examiner

Jasper Kwoh

Group Art Unit

2733

☒ Responsive to communication(s) filed on Sep 14, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 4-21, 23, and 24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-21, 23, and 24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1, 6-8 and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jones et al.

Regarding claim 1, Jones et al disclose a method (i.e. fig. 5) comprising: determining quality of service (QoS) of a public data packet network (500); comparing the QoS obtained in the determining step with a predetermined threshold level for a voice telephone call (i.e. 502, 504, 508); and in response to the result in the comparing step the predetermined threshold level is exceeded, routing the telephone call to a second station through the public data packet network in packet data format (506, 510); routing the voice telephone call to the second station though an Interexchange carrier switched voiced network in PSTN network protocol is the predetermined threshold in not exceeded (col. 6, ll. 37-67; col. 7, ll. 1-35).

Art Unit: 2733

Regarding claims 6-8, Jones et al. disclose exchanging signaling messages between PSTN and Internet (fig. 3). It also determines if the destination is busy (fig. 8) and establishing a circuit in the data packet network (i.e. 610).

Claim 21 is an apparatus claim corresponding to method claim 1. Therefore, the means read on the steps as described above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al.

Art Unit: 2733

Regarding claims 2 and 6, Jones et al. disclose completing the call through an Interexchange carrier switch network if said predetermined threshold level is not exceeded (fig. 5). It is inherent that in order to switch signaling messages will need to be exchanged between routers. In addition, entering a unique service code like *82 is old and well known. It would have been obvious to an ordinary person skilled in the art at the time of the invention to allow the placement of call with this option in order to allow the network increased quality of service.

Claim 23 is apparatus claims corresponding to method claims 2 and 6. Therefore, the means read on the steps as described above.

5. Claims 4-5, 9-20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of Bartholomew et al.

Jones et al. measures round trip duration and ascertaining variance (fig. 9, 900, 902) and routing to the PSTN if a bandwidth level is below a predetermined threshold level (abstract). Bartholomew et al. teach an AIN (907), an ISCP (40), CPRs (i.e. 42, 43) for retrieving an Interexchange carrier identity (col 4, ll. 25-58). Furthermore, input of unique service code, triggering the ISCP in response to an off hook condition, dialing area codes and telephone numbers, are all old and well known. In addition, it is a design choice to compare only if dialed information match information stored in the SCPR in order to conserve resources and only process information where it is the intended recipient. It would have been obvious to an ordinary person skilled in the art at the time of the invention to include the AIN, ISCP, CPRs, as well as

Art Unit: 2733

the old and well known functions of the telephone system in the method of Jones et al. in order for improve the speed and quality of service in an intelligent peripheral communications network.

Regarding claim 24, Jones et al. do not specifically disclose the exact components that comprise the interface. However, Bartholomew et al. teach an interface including a processor (fig. 8) having router (i.e. 800) and packet assembler and disassembler (i.e. 835); and voice compression and decompression (i.e. 713). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include the components as taught by Bartholomew et al. with the system disclosed by Jones in order to allow the gateway to switch selectively calls to the desired module.

Response to Arguments

6. Applicant's arguments filed 9/14/99 have been fully considered but they are not persuasive.

Applicant argues Jones does not disclose or suggest set up of a voice call though the Internet if the quality of service level for data transport exceeds a predetermined threshold level for voice call or set up of the voice call through a traditional PSTN path via an Interexchange carrier if the threshold is not met. Examiner disagrees with the Applicants assertions. Jones does disclose voice call (i.e. col. 2, ll. 64-67; telephone service) that is switchable between the

Art Unit: 2733

Internet (110) and PSTN (108) via an Interexchange carrier (i.e. 304, 306, 308) depending on the threshold of the transmission (i.e. 502, 504, 508; col. 6, ll. 37-67; col. 7, ll. 1-35).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jones discloses that the interface, among many function, routes the data to the desired network, but do not specifically disclose the exact components in the interface. Bartholomew is used as an example of the router and its components which performs the same function as the interface of Jones. Therefore, an artisan of the art would combine the knowledge of the two references. Examiners rejections as stated above are maintained.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Shaffer is cited to show a method and system for increasing QoS at or below a threshold.

b. Riggan et al. is cited to show system and method for prevention of cell loss due to QoS contracts in ATM network.

Art Unit: 2733

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasper Kwoh whose telephone number is (703) 305-0101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (703) 305-4729.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Serial Number: 08/821,027

Page 8

Art Unit: 2733

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

Jasper Kwoh



November 21, 1999



HUY D. VU
PRIMARY EXAMINER